



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

08/828,330

03/28/1997

WILLIAM D. MORGAN

IAEC:007USR1

4766

32425 7590 03/18/2008  
FULBRIGHT & JAWORSKI L.L.P.  
600 CONGRESS AVE.  
SUITE 2400  
AUSTIN, TX 78701

EXAMINER

CANFIELD, ROBERT

ART UNIT

PAPER NUMBER

3600

MAIL DATE

DELIVERY MODE

03/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 08/828,330	<b>Applicant(s)</b> MORGAN, WILLIAM D.	
	<b>Examiner</b> ROBERT J. CANFIELD	<b>Art Unit</b> 3600	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-9, 11, 12, 14, 19, 20, 22, 50-56 and 59-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-9, 11, 12, 14, 19, 20, 22, 50-56 and 59-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/27/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

1. This Office action is in response to the amendment filed 08/27/07. Claims 1-9, 11, 12, 14, 19, 20, 22, 50-56 and 59-70 are pending.
2. The replacement sheet of figure 2 (amended) is accepted. Acknowledgement is made of the cancellation of previously submitted figures 3-5 (new).
3. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,400,549 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.
4. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

**Note that the Statement under 37 CFR 3.73(b) received March 17, 2006 (courtesy copy provided 08/27/07) fails to provide a copy of the assignment or identify the reel and frame number.**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 5-9, 11, 12, 14, 19, 20, 22, 50-56 and 59-70 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the disclosure as originally filed that the panels are ***removably linked*** together in overlapping relationship ***such that gas from wastewater can flow from underneath portions of the panels through gaps between adjacent panels***. There is no mentions whatsoever of gases, **gaps**, or the desirability to allow gases to escape/migrate/travel through gaps. There is no support for ***“non gas tight cover system”***.

The original disclosure only supports only supports a cover comprised of linked panels and that once the cover has been secured in position that the cover can be removed. There is no mention of removably linking or unlinking adjacent panels.

7. Claims 5-9, 11, 12, 14, 19-22 and 50-70 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

See comments in above 112(1) rejection.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 60-62 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,590,714 to Walker.

Walker provides a cover comprised of a plurality of rectangular panels comprised of high density polyethylene material or “geomembrane”, membranes 1 and 2

having a compressible insulating material (3) therein. As the insulating material is compressible it does not completely fill the membranes 1 and 2. The panels are capable of being used over wastewater and thus are "configured for use over wastewater". Figure 3 shows multiple overlapping openings (41) which have screw type fasteners (I) passed there through. Screw type fasteners are inherently removable and as best understood gas would be capable of traveling from below the cover through "gaps" between adjacent grommets 41.

10. Applicant's arguments filed 08/27/07 have been fully considered but they are not persuasive.

The declaration under 37 CFR 1.132 filed 08/27/07 is insufficient to overcome the rejection of claims based upon 112(1), written description, as set forth in the last Office action because:

Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991) (Expert described how he would construct elements necessary to the claimed invention whose construction was not described in the application or the prior art; this was not sufficient to demonstrate that such construction was well-known to those of ordinary skill in the art.); *In re Smyth*, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).

Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered. *In re Oppenauer*, 143 F.2d 974, 62 USPQ 297 (CCPA 1944).

Applicant argues and relies upon the declaration to support the argument that the original disclosure conveys the subject matter such that it would be understood by one of ordinary skill in the art and that as originally disclosed the panels could ***necessarily*** be delinked or removably linked, that there would ***necessarily*** be gaps between adjacent panels that gas could pass through, and that the system is ***necessarily*** non-gas tight. This is not found persuasive. While these features may possible or even likely they are not necessarily evident form the original disclosure. There is no mention or discussion of how heavy the panels are or how tight they are fastened linked to one another or any mention whatsoever or cutting or unclamping or unlinking adjacent panels. There is no description of the terms “gaps” or “removably linked” and they are not necessarily apparent.

11. Claims 1-4 are allowed.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. The IDS filed 08/27/07 has been considered. An initialed copy of the 1449 form is attached.

14. Any inquiry concerning this communication should be directed to ROBERT J. CANFIELD at telephone number (571)272-6840.

/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635

Robert J Canfield  
SPE  
Art Unit 3600